

REMARKS

This responds to the Office Action mailed on January 14, 2004. In this response, no claims are amended, cancelled, or added. As a result, claims 1 – 20 remain pending in this patent application.

§103 Rejection of the Claims

Claims 1-4, 9 and 10 were rejected under 35 U.S.C. § 103(a) for obviousness over Marcovecchio et al. (U.S. Patent No. 6,512,951).

The present patent application was filed on April 5, 2001. Marcovecchio et al. has a filing date of September 14, 2000, and did not publish until it issued on January 28, 2003. Consequently, Marcovecchio et al. may be available as prior art (if at all) only under 35 U.S.C. 102(e), and furthermore, is disqualified as prior art under 35 U.S.C. 102(e)/103 under the American Inventors Protection Act (AIPA) of 1999. Therefore, Applicant does not admit that the cited Marcovecchio et al. reference is prior art and reserves the right to "swear behind" Marcovecchio et al., as provided for under 37 C.F.R. 1.131, as well as any other references that may be available (if at all) only under 35 U.S.C. 102(e).

Applicant respectfully submits that the Marcovecchio et al. reference is disqualified by the American Inventors Protection Act (AIPA) of 1999 from being used as a reference against the present patent application under 35 U.S.C. § 102(e)/103. Applicant declares that, to the best of Applicant's knowledge, at the time the present invention was made, the present application and Marcovecchio et al. (U.S. Patent No. 6,512,951) were owned by the same entity, i.e., Cardiac Pacemakers, Inc. Applicant believes, therefore, that the Marcovecchio et al. reference is disqualified as art for purposes of section 102(e)/103(a) under 35 U.S.C. 103(c). Accordingly, Applicant respectfully requests withdrawal of this basis of rejection insofar as it relies upon the Marcovecchio et al. reference.

Moreover, Applicant respectfully submits that no *prima facie* case of obviousness presently exists with respect to these claims. The Office Action admits that Marcovecchio et al. does not show that a shockable present RR interval requires that a ventricular sensing period of the present RR interval be less than or equal to a first predetermined value. Moreover, in making this single-reference obviousness rejection, the Office Action fails to cite any other reference as

disclosing the missing element. To the extent the Examiner is relying on personal knowledge to assert that it is notoriously well known in the art that a shockable present RR interval requires that a ventricular sensing refractory period of the present RR interval is less than or equal to a first predetermined value, Applicant timely objects to such reliance on official notice, and respectfully requests that the Examiner provide a reference supporting such a teaching or suggestion. See MPEP § 2144.03. In sum, because no *prima facie* case of obviousness presently exists with respect to claims 1-4, 9 and 10, Applicant respectfully requests withdrawal of this basis of rejection of these claims.

Allowable Subject Matter

Applicant gratefully acknowledges the allowance of claims 11-20.

Claims 5-8 were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, in view of the above, Applicant respectfully submits that these claims are patentable in their present form. Accordingly, Applicant respectfully requests allowance of these claims.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6951 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743

Respectfully submitted,

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By his Representatives,

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Date April 5, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, MS: Non-Fee Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10 day of April, 2004.

Paula Suchy
Name

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Signature